

IN THE DRAWINGS

The Examiner's permission is requested to make the following changes:

- FIGs. 1-5 change sheet numbers from x/5 to x/6; and
- Add FIG. 6.

As required under 37 CFR 1.84 "Annotated Sheet Showing Changes" and Replacement Sheets for Figures 1-5 are attached hereto. Newly added Figure 6 is also attached hereto.

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REMARKS/ARGUMENTS

Applicant has studied the Office Action dated March 31, 2006 and has made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-24 are pending. Claims 1, 10, 18, 21, 22, 23, and 24 are amended. No new matter has been added. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (Page 2) objected to the drawings under 37 CFR 1.83(a) for features claimed but not shown in the drawings;
- (Page 3) rejected claims 21-24 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- (Page 4) rejected claims 1, 6-7, 10-12, and 15 under 35 U.S.C. § 102(b) as being anticipated by Hoh et al. (U.S. Patent No. 4,232,068);
- (Page 5) rejected claims 1-2 and 9 under 35 U.S.C. § 102(b) as being anticipated by Colt (U.S. Patent No. 1,552,912);
- (Page 6) rejected claims 18-19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068);
- (Page 7) rejected claims 4, 8, 13, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068) in view of Grove Products, Inc.; and
- (Page 8) rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Colt (U.S. Patent No. 1,552,912) in view of Hartin (DES 423,909).

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(Page 2) Objection to the Drawings for Features Not Shown

As noted above, the Examiner objected to the drawings under 37 CFR 1.83(a) for features claimed but not shown in the drawings. Specifically, the Examiner stated that "the method for aligning at least two elements by connecting a guide-line between corresponding grooves or holes in the [] must be shown or feature(s) cancelled from the claim(s)."

FIG. 6 has been added to the instant application. FIG. 6 shows that described in paragraph 0054 and claims 21-24 of the application as originally filed. Specifically, FIG. 6 shows two shims 16 utilized to align several frames 3 along a single plane by connecting a guide-line, such as a string, through grooves 21 and/or 23 of the tabs 11 of the shims 16 located between the frames 3. New FIG. 6 also shows thru-holes 20, 24, 18, and 19, and slot 22 being used for alignment of the frames 3. No new matter was added by the addition of FIG. 6.

It is therefore believed that the drawings, as amended, are in compliance with the requirements of 37 C.F.R. 1.83(a). Applicant submits that the Examiner's objections to the Drawings have been overcome and the Examiner's rejection should be withdrawn.

(Page 3) Rejection under 35 U.S.C. §112

The Examiner rejected claims 21-24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claims 21-24 to more clearly and affirmatively recite that a guide-line is threaded or connected through the hole or groove in "the at least one extending arm of a shim in a first of the at least two different gaps to a corresponding hole in the extending arm of a shim in a second of the at least two different gaps." This more clearly and affirmatively recites which two shims are being connected by the

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guide-line. Support for this amendment may be found in the specification as originally filed, see for example para. 0054. No new matter was added.

In view of the amendment to Claims 21-24 and the remarks above, Applicant believes that the rejection of Claims 21-24, under 35 U.S.C. § 112, second paragraph, as discussed above, has been overcome. Applicant requests that the Examiner withdraw the rejection of Claims 21-24.

(Page 4) Rejection under 35 U.S.C. §102(b), Hoh et al.

As noted above, the Examiner rejected claims 1, 6-7, 10-12, and 15 under 35 U.S.C. § 102(b) as being anticipated by Hoh et al. (U.S. Patent No. 4,232,068). Claims 1 and 10 have been amended to distinguish and to more clearly define the present invention over Hoh et al. Support for the changes is found in Figs. 2B-4 of the specification of the instant application. No new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Amended independent claim 1 recites, *inter alia*:

...
a body formed with a first portion and a second portion; and
a slot dividing the first portion of said body into a pair of wave-shaped **extending arms, wherein a trough and a peak of the wave-shaped extending arms is parallel to a junction between the first portion and the second portion.** (emphasis added)

Amended claim 10 recites, *inter alia*:

... each with a first portion and a second portion and formed with a slot dividing the first portion into a pair of wave-shaped **extending arms, wherein a trough and a peak of the wave-shaped extending arms is parallel to a junction between the first portion and the second portion** ... (emphasis added)

The present invention discloses a shim for windows, doors, and other similar applications. The inventive shim provides compressible wave-shaped arms that allow it

to secure itself in openings of various widths. Instant specification, para. 0049. The shim of the present invention has a body 10 that is divided into two portions. *Id.*, para. 0048. A slot 7 divides one of the portions into a pair of wave-shaped extending arms 8 and 9. *Id.*, para. 0048 and FIGs. 2A-5.

As can be seen in FIGs. 2A and 2B of the instant application, the peaks and troughs travel across both arms and are in a direction that is parallel to a junction that separates the arm portion from the other portion of the body.

A side view of the shim 16, as shown in FIG. 2B, shows the wave shape, which has well defined peaks 12 and troughs 13 in the arms. See also, instant specification, para. 0048. Therefore, the wave travels along the length of the arms. Because of this wave orientation, the arms 8 and 9 of the shim, when compressed, are able to naturally "extend" in a direction away from the main body section 10 to which the legs are attached.

Hoh et al. discloses a shim with "longitudinal, parallel, narrow, grooves and ridges". Hoh et al., col. 3, lines 51-52. The grooves and ridges are present on the Hoh et al. shim only to "minimiz[e] any tendency of the stacked shims to shift **laterally** with respect to each other." Hoh et al., col. 3, lines 59-63. The lateral grooves and ridges are shown in FIGs. 1, 2, and 5 of Hoh et al. and run the entire length of the shim. These grooves and ridges are described by Hoh et al. as "striations" and do not render the arms "wave-shaped", nor do they allow the shim to compress and the arms to "extend." Hoh et al., col. 3, lines 49-50.

Even if the Examiner maintains that the grooves and ridges of Hoh et al. are wave shaped, the direction of the wave is from one side of the shim to the other side or, more specifically, uniform across the arm section.¹ Therefore, peaks and troughs of the grooves and ridges run the length of the arms and are perpendicular to any junction between the arm portion of the shim and the rest of the shim body in Hoh et al.

¹ Applicant makes no admission that the grooves and ridges of Hoh et al. are wave shaped at all.

Therefore, Hoh et al. do not disclose a slot dividing the first portion of said body into a pair of wave-shaped extending arms, wherein a trough and a peak of the wave-shaped extending arms is parallel to a junction between the first portion and the second portion, as recited in claims 1 and 10 of the instant application.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Hoh et al.² Because the elements in independent claims 1 and 10 of the instant application are not taught or disclosed by Hoh et al., the shim of Hoh et al. does not anticipate the present invention. Dependent claims 2-9 and 11-20 are believed to be patentable as well because they all are ultimately dependent on either claim 1 or 10. Accordingly, the present invention distinguishes over Hoh et al. for at least this reason. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(Page 5) Rejection under 35 U.S.C. §102(b), Colt

As noted above, the Examiner rejected claims 1-2 and 9 under 35 U.S.C. § 102(b) as being anticipated by Colt (U.S. Patent No. 1,552,912).

Amended claim 1 recites, *inter alia*:

a body ... a slot dividing the first portion of said body ... into a pair of wave-shaped extending arms... (emphasis added)

The shim of the present invention has a body 10 that is divided into two portion with one portion having wave-shaped arms 8 and 9. Instant specification and FIG. 2A-5. The arms of the shim of the instant invention are compressible, which allows the arms to "extend" away from the body 10 of the shim.

² See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

Colt discloses a wedge-shaped shim. Colt, FIG. 1. The arms of the shim in Colt continuously "taper" and, therefore, do not have peaks or troughs and are in no way "wave shaped." Colt, page 2, lines 1-4 and FIGs. 1-10. In one embodiment of Colt, the shim is provided with "angularly shaped re-enforcing ribs 16". Colt, page 2, lines 15-18. The ribs 16 are also wedge-shaped, but do not run the entire length of the arms of the shim. Colt, FIG. 2. Therefore, the ribs 16 of Colt, are neither "wave-shaped" nor are they part of the body.

Furthermore, the tapered ribs 14 and 15 of Colt are on straight legs 12 and 13, which are solid. See FIGs. 1-10. The legs 14 and 15 of Colt are not compressible and, as a result, are not "extending".

Colt clearly does not disclose a pair of wave-shaped arms, nor does Colt disclose "extending" arms, as recited in claim 1 of the instant application.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated.³ Because the elements in independent claim 1 of the instant application are not taught or disclosed by Colt, the shim of Colt does not anticipate the present invention. Dependent claims 2-9 are believed to be patentable as well because they all are ultimately dependent on claim 1. Accordingly, the present invention distinguishes over Colt for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome and that the Examiner should withdraw the rejection.

(Page 6) Rejection under 35 U.S.C. §103(a), Hoh et al.

As noted above, the Examiner rejected claims 18-19 and 20 under 35 U.S.C. §

³ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068)⁴. Independent claim 18 has been amended to distinguish and to more clearly define the present invention over Hoh et al. Support for the changes is found in Figs. 2B-4 of the specification of the instant application. No new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Amended independent claim 18 recites, *inter alia*:

...
a slot dividing the first portion of the body into a pair of wave-shaped extending arms, wherein a trough and a peak of the wave-shaped extending arms is parallel to a junction between the first portion and the second portion.

As stated in the section above, entitled "(Page 4) Rejection under 35 U.S.C. §102(b), Hoh et al.," Hoh et al. discloses a shim with "longitudinal, parallel, narrow, grooves and ridges". Hoh et al., col. 3, lines 51-52. The grooves and ridges are present on the Hoh et al. shim only to "minimiz[e] any tendency of the stacked shims to shift **laterally** with respect to each other." Hoh et al., col. 3, lines 59-63. The lateral grooves and ridges are shown in FIGs. 1, 2, and 5 of Hoh et al. and run the entire length of the shim. These grooves and ridges do not render the arms "wave-shaped", nor do they allow the shim to compress and the arms to extend. The grooves and ridges of the Hoh et al. do not have peaks and troughs that are parallel to a junction between the arm portion of the shim and the body portion.

Therefore, Hoh et al. do not disclose a slot dividing the first portion of the body into a pair of wave-shaped extending arms, wherein a trough and a peak of the wave-shaped extending arms is parallel to a junction between the first portion and the second portion, as recited in claim 18 of the instant application.

⁴ Applicants make no statement as to whether such a combination is even proper.

It is accordingly believed to be clear that Hoh et al. neither shows nor suggests the features of claim 18. Claim 18 is, therefore, believed to be patentable over the cited art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 18.

(Page 7) Rejection under 35 U.S.C. §103(a), Hoh et al. in view of Grove Products

As noted above, the Examiner rejected claims 4, 8, 13, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068) in view of Grove Products, Inc.⁵

The deficiencies of Hoh et al. are discussed above in the section entitled "(Page 4) Rejection under 35 U.S.C. §102(b), Hoh et al."

Grove Products Inc. manufactures a traditional shim that is a flat piece of material with a groove separating two arms. The Grove Products shim does not have a wave shape or have extending arms.

When there is no suggestion or teaching in the prior art, the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Hoh et al. taken alone and/or in view of Grove Products, Inc. does not even suggest, teach or mention a wave-shaped body... a pair of wave-shaped extending arms, wherein a direction of the wave is away from the end, as recited in claims 1 and 10 of the instant application.

Accordingly, claims 1 and 10 distinguish over Hoh et al. taken alone and/or in view of Grove Products, Inc. Claims 4 and 8 depend from claim 1 and claims 13 and

⁵ Applicants make no statement as to whether such a combination is even proper.

16 depend from claim 10. Therefore, claims 4, 8, 13, and 16 are believed to be allowable as well.

For the foregoing reasons, independent claims 1 and 10, as amended, distinguish over Hoh et al. taken alone and/or in view of Grove Products, Inc. Claims 4 and 8 depend from independent claim 1 and claims 13 and 16 depend from independent claim 10. Since dependent claims contain all the limitations of the independent claims, claims 4, 8, 13, and 16 distinguish over Hoh et al. taken alone and/or in view of Grove Products, Inc. as well, and the Examiner's rejection should be withdrawn.

(Page 8) Rejection under 35 U.S.C. §103(a), Colt in view of Hartin

As noted above, the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Colt (U.S. Patent No. 1,552,912) in view of Hartin (DES 423909).⁶

In the section entitled "(Page 5) Rejection under 35 U.S.C. §102(b), Colt" above, the deficiencies of the prior-art shim disclosed in the Colt reference were discussed.

The Examiner cites Hartin. However, not only does Hartin fail to show wave shaped extending arms, wherein a direction of the wave is away from the end, Hartin does not show a wave shape at all.

Claim 5 depends directly from newly amended claim 1. Independent claim 1 distinguishes over Colt in view of Hartin. Since dependent claims contain all the limitations of the independent claims, claim 5 distinguishes over Colt and Hartin, as well. The Applicant respectfully requests that the Examiner's rejection of claim 5 be withdrawn.

⁶ Applicants make no statement as to whether such a combination is even proper.

CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicant acknowledges the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and the attorneys.

The present application, after entry of this amendment, comprises twenty four (24) claims, including seven (7) independent claims. Applicant has previously paid for twenty four (24) claims including seven (7) independent claims. Applicant, therefore, believes that an additional fee for claims amendment is currently not due.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 50-1556.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

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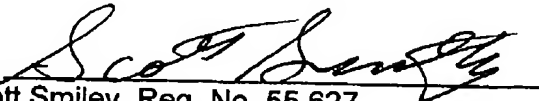
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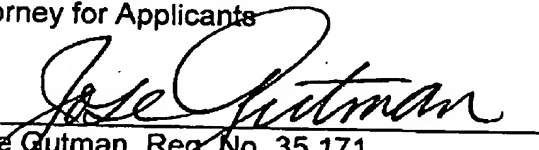
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PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: June 30, 2006

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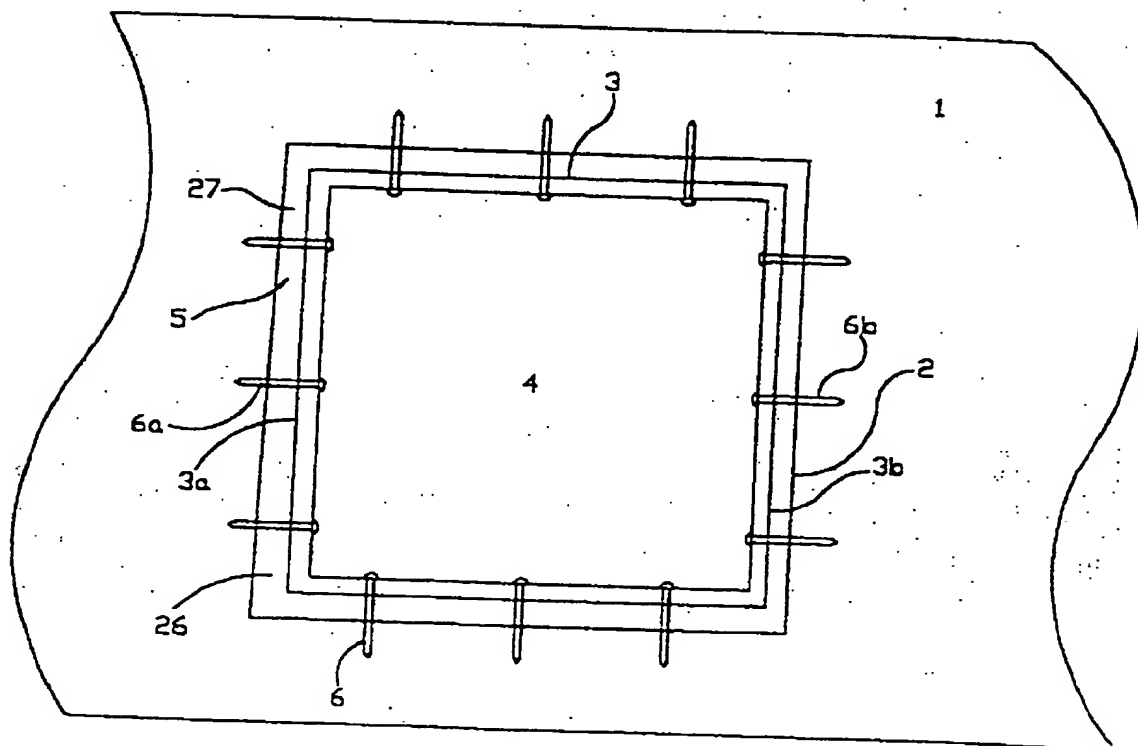
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FIG. 1



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FIG. 2A

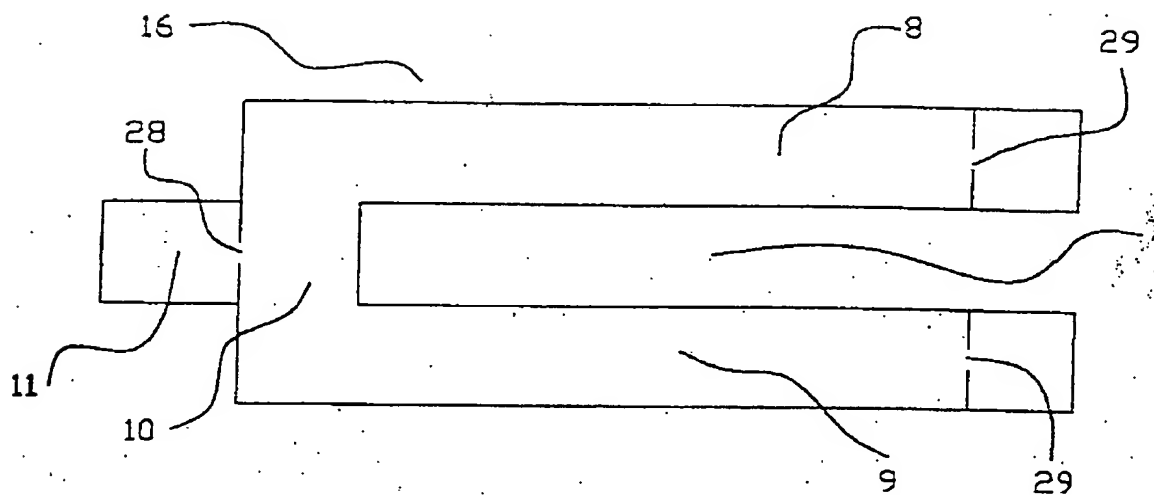
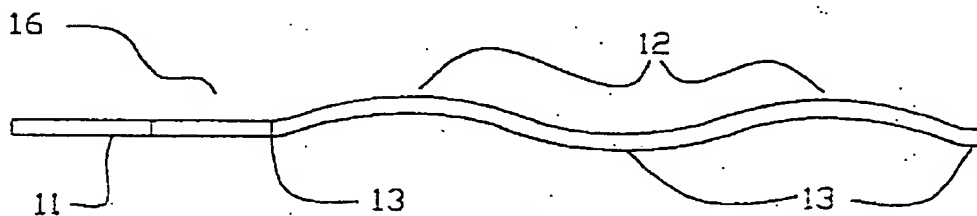


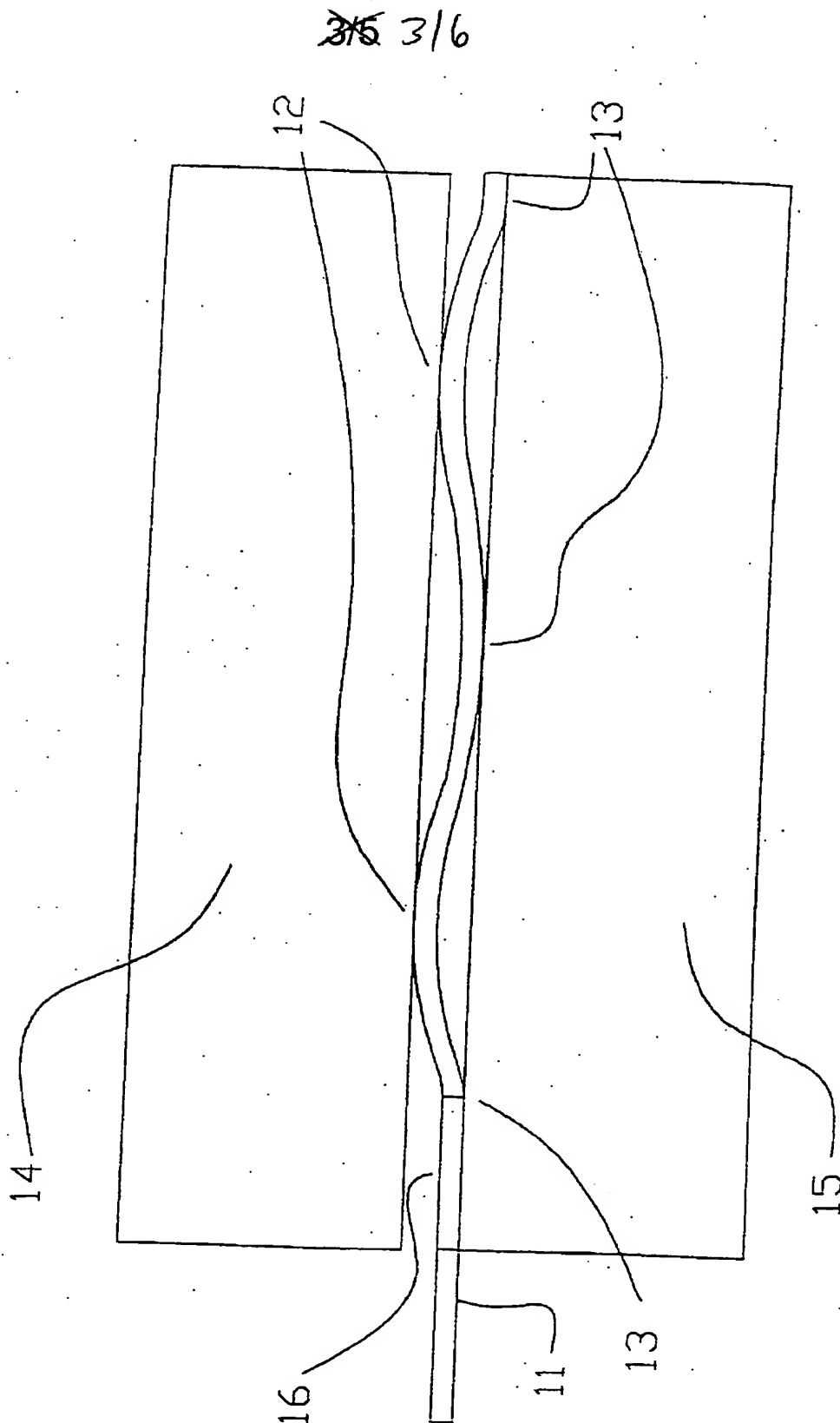
FIG. 2B



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FIG. 3

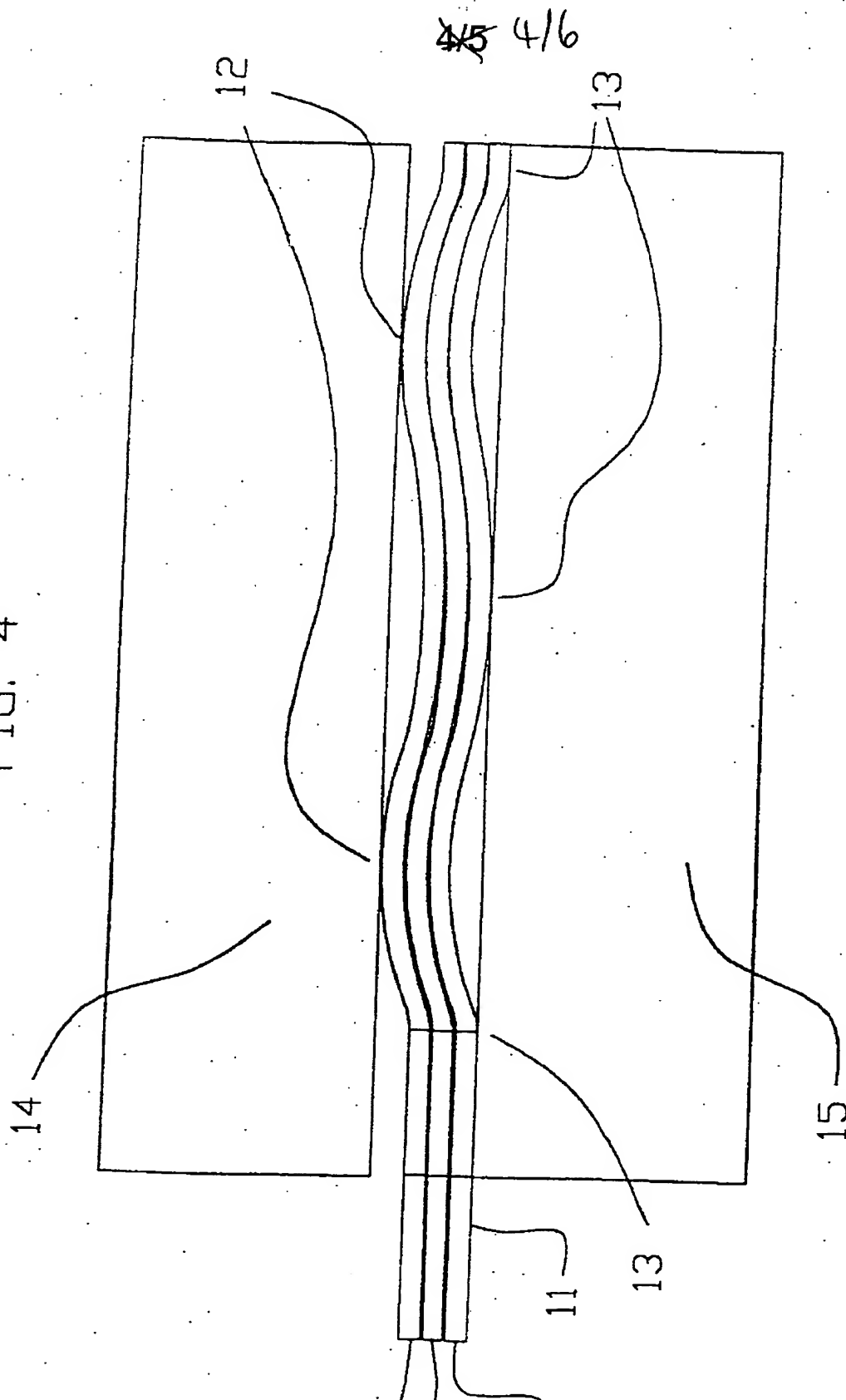


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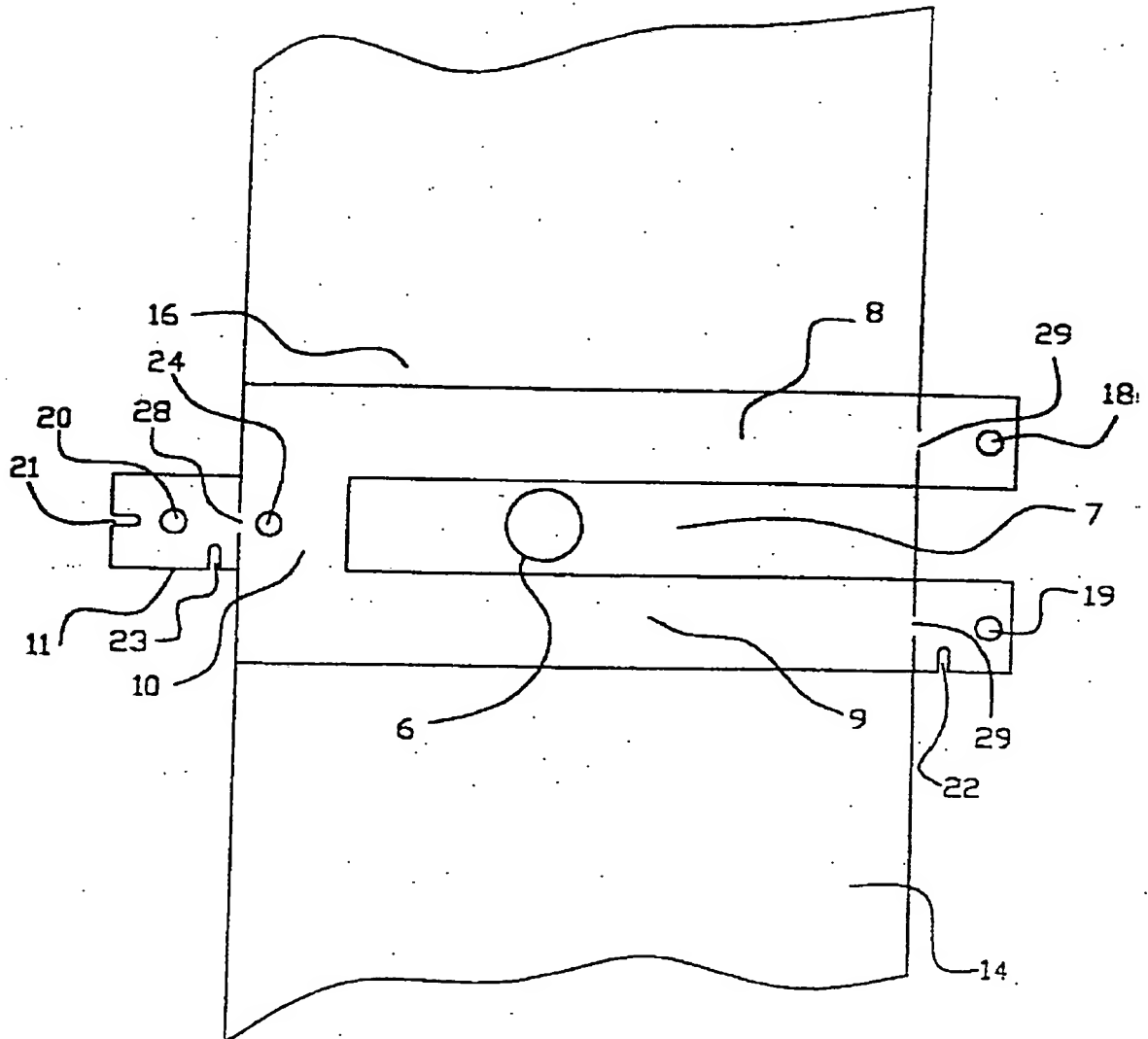
FIG. 4



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FIG. 5



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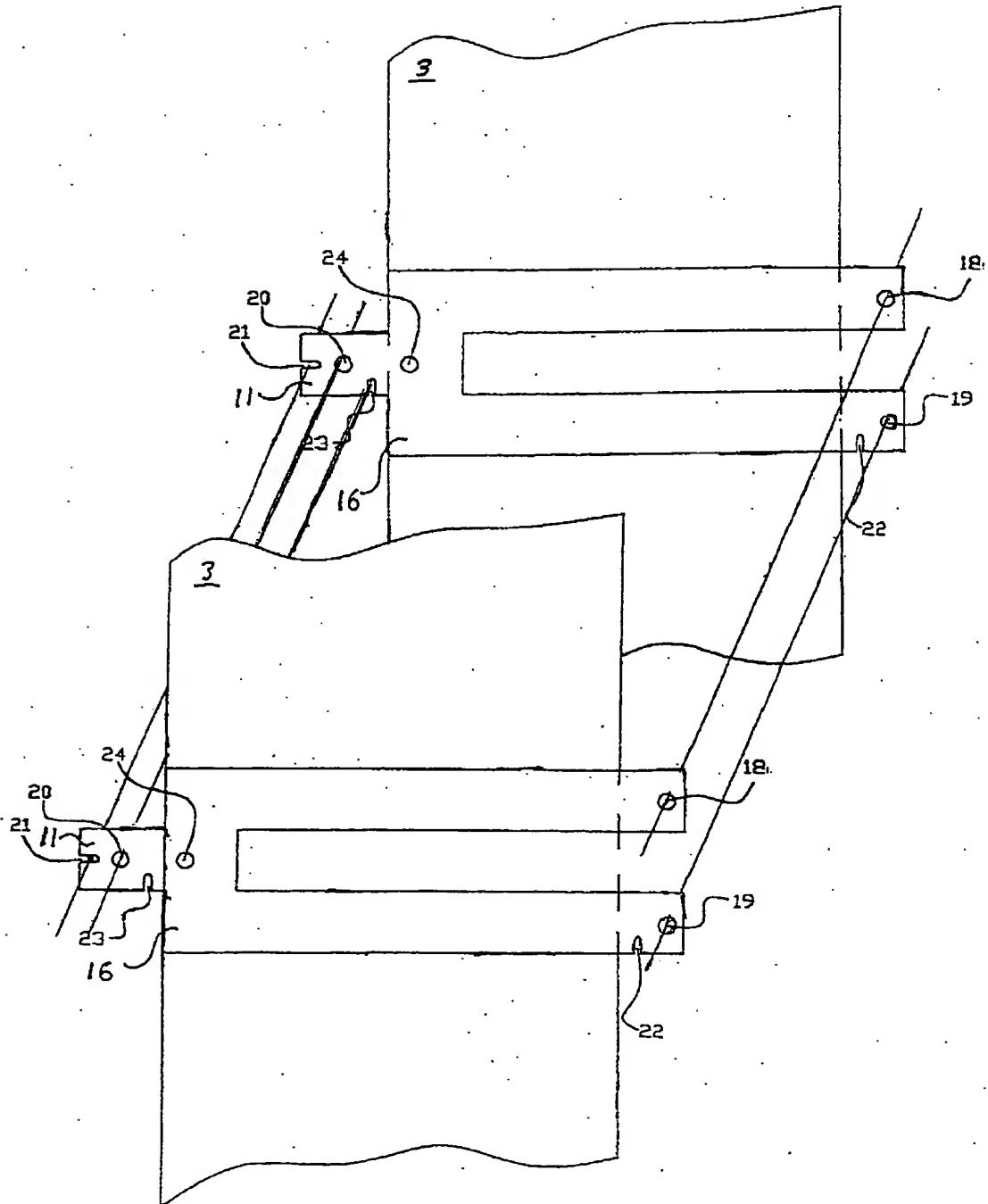


FIG. 6